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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/498,856 02/04/00 OHNISHI

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PM82/0104

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EXAMINER

ZANELLI, M

ART UNIT

PAPER NUMBER

3661

DATE MAILED:

01/04/01

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/498,856

Applicant(s)

Ohnishi et al.

Examiner

Zmelli

Group Art Unit

3661

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 7/7/00
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 12-14 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 12-14 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☒ received in Application No. (Series Code/Serial Number) 07/985,199
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 4
- ☐ Interview Summary, PTO-413
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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DETAILED ACTION

1. This application is acknowledged as a Continuation of Reissue application no. 09/064765. The preliminary amendments dated 2/4/00 and 7/7/00 have been entered. Claims 12-14 are pending. Applicant is advised that the preliminary amendments are not in compliance with 37 CFR 1.173(c) insofar that the status of all claims is not stated or an explanation of support in the specification for the amended claims. Future amendments must be in compliance to avoid a non-responsive notice.
2. Acknowledgment is made of the receipt of the IDS filed 7/7/00. The documents have not been considered because applicant has failed to provide copies. Note that JP-3134363A was cited during prosecution of the 5,510,982 patent application.
3. This application is objected to under 37 CFR 3.73(b) as lacking evidence of the right of the assignee to take action. See MPEP § 324.

A proper assent of the assignee in compliance with 37 CFR 3.73(b) is required in reply to this Office action.

4. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

- A. The declaration specifies "sole" inventor although multiple ("joint") inventors are identified. 37 CFR 1.63(a)(4)

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B. The postal address/residence information has not been provided for each inventor. 37 CFR 1.63(a)(3)

5. Claims 12-14 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defects in the declaration is set forth in the discussion above in this Office action.

6. Claims 12-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. As per claim 12, at line 11 "the estimated values" lacks antecedence. At line 14 it is unclear what the word before "selected" is (value?).

B. As per claim 13, at lines 11 and 13 "the estimated value" lacks antecedence.

C. As per claim 14, at line 4 it is unclear how one can "estimate" an input-torque converter since this is a mechanical device. At lines 10-11 "the estimated values" lacks antecedence. At line 17 "the estimated value" lacks antecedence. At line 18 "the calculated deviation" lacks antecedence. At line 21 "the selecting unit" lacks antecedence.

7. Claims 12-14 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46

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USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

A. As per reissue claims 12-14, the claims are directed to a control system for an automatic transmission with a torque converter including a control unit for controlling the transmission using an estimated torque value. Patented claims 1, 2, 4, 5, 6, and 7 are directed to a system and method for controlling selection of a gear position for an automatic transmission. Further, the patented claims include weight estimation means, acceleration input means, output torque estimation means, running load means, memory means, shift schedule unit, and gear shift determination means. The reissue claims merely include first and second input torque estimating units, selecting unit, and a control unit. Reissue claim 14 also includes a storing unit and a calculation unit. Thus, the reissue claims are broader in at least some aspects relative to the patented claims.

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B. Since broader aspects have been shown, one looks to see if the broader aspects relate to surrendered subject matter; specifically, prosecution history. The exact language of the patented claims noted in the Reasons for Allowance does not appear anywhere in the reissue claims. The particular situation here corresponds to Example C described in MPEP 1412.02:

“If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists.”

“The limitation omitted in the reissue claims was present in the claims of the original application. The examiner's reasons for allowance in the original application stated that it was that limitation which distinguished over a potential combination of references X and Y. Applicant did not present on the record a counter statement or comment as to the examiner's reasons for allowance, and permitted the claims to issue. The omitted limitation is thus established as relating to subject matter previously surrendered.”

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C. For example, reissue claim 12 at a minimum must include the preamble, output torque estimation means, and wherein clause of patent claim 1 (original application claim 5) because the Reasons for Allowance specifically states:

"Claims 5 ... allowable because the combination of the means/step for estimating the output torque by one of two alternative methods are respectively recited in the claims, depending on whether the ratio between the input and output speeds of the torque converter is greater than a predetermined value, with the other limitations of the respective claims is deemed to have not been taught by the cited prior art".

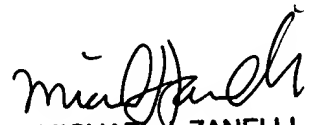
Since applicant did not present on the record a counter statement or comment as to the examiner's reasons for allowance, and permitted the claims to issue, the omitted limitation(s) is thus established as relating to subject matter previously surrendered.

8. Applicant is reminded of the proper procedures for amending claims in a reissue application. See 37 CFR 1.121(b)(2).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Michael Zanelli** whose telephone number is **(703) 305-9756** (M-Th, 6:30-5:00 PM).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(703) 308-1113**.

/mjz
December 19, 2000


MICHAEL J. ZANELLI
PRIMARY EXAMINER